



AUG 17 2001

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In re Application of	:	
POPOVSKY	:	DECISION ON PETITION
Serial No.: 09/701,807	:	
PCT No.: PCT/AU99/00422	:	UNDER 37 CFR 1.47(b)
Int. Filing Date: 31 May 1999	:	
Priority Date: 03 June 1998	:	
Atty Docket No.: P40.2-9585	:	
For: PRE-FILLED CONTAINER	:	

This is a response to the petition under 37 CFR 1.47(b) filed 22 February 2001 to accept the application without the signature of inventor Frank Popovsky.

BACKGROUND

On 31 May 1999, applicant filed international application PCT/AU99/00422, which claimed priority of an earlier application filed 03 June 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 December 1999. A Demand for international preliminary examination, in which the United States was elected was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 03 December 2000.

On 01 December 2000, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1). An oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 22 December 2000, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was also notified of the need to pay the \$130.00 surcharge for providing the oath or declaration later than 30 months from the earliest claimed priority date. Applicant was given one month to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 22 February 2001, applicant responded with the present petition accompanied by a petition for a one-month extension of time and payment of the \$110.00 extension fee.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(I); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. With the filing of the present petition and papers, applicant has satisfied items (1), (3), (5) and (6).

Regarding item (2) above, petitioner has not provided firsthand knowledge that the non-signing inventor, Mr. Frank Popovsky refuses to execute a declaration for the present application. The enclosed declaration from Mr. Vidas only contains a reference to a letter from Australian counsel, Mr. Chambers, who apparently has firsthand knowledge of the purported refusal. In addition, no evidence has been presented to show that Mr. Popovsky has been provided with a complete set of the application papers as required under the Manual of Patent Examining Procedure (MPEP) section 409.03 (d). The letter from Mr. Chambers (Applicant's Exhibit C) states that Mr. Popovsky continues to refuse to execute the declaration. Yet, nowhere in this letter nor in the petition is it stated that a complete set of papers (namely, specification, including claims, drawings and oath or declaration) was presented to Mr. Popovsky. In view of the above, item (2) has not been satisfied. In order to satisfy this requirement, such a statement must be signed by someone with first hand knowledge and must set forth specific facts as to the attempts to obtain Mr. Popovsky's signature, including presenting him with a complete set of application papers and his subsequent refusal.

As to Item (4), the enclosed declaration is insufficient. The declaration is not in compliance with 37 CFR 1.497 (a) and (b). As such, applicant has failed to satisfy Item (4).

CONCLUSION

Applicant's petition under 37 CFR 1.47(b) is **DISMISSED**.

Applicant included a check for \$110.00 as payment of the surcharge for providing an oath or declaration later than thirty months from the priority date. The surcharge is \$130.00, therefore, as authorized, \$20.00 will be deducted from Deposit Account No.: 22-0350.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mailing date of this decision. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extension of time may be obtained under 37 CFR 1.136(a).

Should status under 37 CFR 1.47(b) not be successfully completed, the international

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application will be viewed as having become abandoned with respect to the United States of America.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



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